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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,694	10/29/2003	Martin Pepper	GB920030054US1	5259

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EXAMINER	
LEE, WILSON	

ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/696,694	PEPPER ET AL.	
	Examiner	Art Unit	
	Wilson Lee	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *12-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *12-16* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2/7/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Restriction/Election

Applicant elects Group 1 of claims 1-11 with traverse.

As stated in the previous restriction requirement, the product shown in Group II can perform steps different from Group I while Group I can be practiced with a product being different from Group II.

Further, the issue of burden merely plays a minor role for the basis to support the restriction requirement. Since it has been concluded that the pending application includes two separate distinctive and independent inventions, the restriction is therefore proper.

In particular, it appears that applicant believes the issue of burden only arises from the search of prior art and examination of the application in determining the patentability of the claimed invention. However, applicant is respectfully reminded that conducting a search on application merely plays a small part of examining the invention. Burden may also arise from prosecuting multiple inventions in a single application. Such a type prosecution merely leads to complication in patentability determination that may ultimately sacrifices the quality of patentability determination. In view of this reason, a restriction imposed is clearly proper.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Rejections – 35 U.S.C. 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The disclosed invention is inoperative and therefore lacks utility. Because Claim 1 lacks at least one step for conditioning the outcome if the method determines that the identified referenced resource is stored in the storage device, and the outcome if the method determines that the identified referenced resource is not stored in the storage device.

As to Claim 9, it lacks at least one step for conditioning the outcome if the method determines that the one or more referenced resource is stored in the storage device, and the outcome if the method determines that the one or more referenced resource is not stored in the storage device.

Claim Rejections – 35 U.S.C. 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, "in response to an unsuccessful determining step" is vague whether it refers the determining step in claim 1 or another new determining step. Further, it does not specify what the condition of being unsuccessful step. (whether being hacked, being PC shut down, or the size of the resource is too large to be stored?)

Claim Rejections – 35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 8, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Lamburt (6,578,056).

Regarding Claim 1, Lamburt discloses a method for archiving a markup language document comprising at least one referenced resource and a storage device for storing at least one referenced resource, the method comprising the steps of:

- identifying at least one referenced resource in the document (See Col. 1, line 59 to Col. 2, line 22, Col. 28, lines 50-67),
- determining if the at least one identified referenced resource is stored in the storage device (step 948) (Figure 29); and
- in response to an unsuccessful determining step, storing the at least one identified referenced resource in the storage device (See step 952) (Figure 29).

Regarding Claim 2, Lamburt discloses that the identifying step comprises:

- parsing at least one tag contained within the document, wherein each tag corresponds to a referenced resource (See Col. 9, lines 55-62, Col. 33, line 35 to Col. 34, line 4).

Regarding Claim 3, Lamburt discloses that the step of determining comprises:

- performing a query on the storage device to determine a match between each identified referenced resource in the document and the referenced resources stored in the storage device (See Col. 1, line 59 to Col. 2, line 21).

Regarding Claim 4, Lamburt discloses that if a match is found, the referenced resource is not stored again in the storage device (See Figure 29, the method skips the storing step).

Regarding Claim 5, Lamburt discloses that one version of a referenced resource is stored in the data store (cache) (See Figure 29).

Regarding Claim 6, Lamburt discloses that an identified referenced resource is selected from the group consisting of a style sheet, a data type definition file, and an image (See Col. 1, lines 13-27).

Regarding Claim 8, Lamburt discloses a computer program product directly loadable into the internal memory of a digital computer, comprising software code portions for performing, when the product is run on a computer, the method as claimed in claim 1 (See Col. 1, line 13-27, Col. 2, lines 38-40, Col. 4, lines 54-67).

Claims 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Lal (6,684,204).

Regarding Claim 9, Lal discloses a method for retrieving an archived markup language document from a storage device comprising the steps (See Abstract, Col. 5-6) of:

- receiving a search request (e.g. receiving a query) to retrieve an archived document from the document device;

- identifying one or more referenced resources within the requested archived document (e.g. identifying one of the plurality of tags);
- determining if the one or more referenced resources are stored in the storage device (e.g. matching the query with the tags of the documents); and
- retrieving the requested archived document and the one or more referenced resources from the storage device (e.g. extracting the information).

Regarding Claim 10, Lal discloses that the markup language document comprises an XML document (See abstract).

Regarding Claim 11, Lal discloses a computer program comprising software code for performing the method (See Col. 3, line 64 to Col. 4, line 68).

Claim Rejections – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lamburt (6,578,056)

Regarding Claim 7, Lamburt discloses that the markup language document comprises an SGML document (See Col. 8, lines 1-24) but does not explicitly disclose XML. However, it would have been obvious to one of ordinary skill in the art to include XML since XML is a subset of SGML for the purpose to facilitate the sharing of data across different system, particularly systems connected via

the Internet. Such knowledge is known to a skilled in the art and posted on http://en.wikipedia.org/wiki/XML.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Guest et al. (7,020,667) discloses a system and method for data retrieval and collection in an structured format. Burton et al. (6,947,991) discloses a method for exposing network administration stored in a directory. Beged-Dov et al. (6,862,588) discloses a hybrid parsing system and method. Chau et al. (6,643,633) discloses a storing fragmented XML data into a relational database. Huang et al. (6,601,075) discloses a system of banking and retrieving documents based on authority scores. Anderson et al. (6,510,434) disclose a system and method for retrieving information from a database using an index of XML tags and metafiles. Cheng et al. (6,366,934) discloses a method and apparatus for querying structured documents using a database extender.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to Technology Center 2800 applications may be submitted to Technology Center 2800 by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wilson Lee
Primary Examiner
U.S. Patent & Trademark Office

6/24/06